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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/295,329	04/21/1999	YASUMASA KAWABE	Q54114	7050

7590

05/23/2002

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EXAMINER

CLARKE, YVETTE M

ART UNIT	PAPER NUMBER
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1752

26

DATE MAILED: 05/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

MF=24

Advisory Action

Application No.

09/295,329

Applicant(s)

KAWABE ET AL.

Examiner

Yvette M Clarke

Art Unit

1752

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 May 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 16-22.

Claim(s) objected to: 23-26.

Claim(s) rejected: 1-15.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

Continuation of 3. Applicant's reply has overcome the following rejection(s): the rejection of claims 23-26 under 35 USC 112, 2nd paragraph and the Double Patenting rejection of claims 1, 3, 8 and 14-15 over claims 1-16 of US 6159656 A .

Continuation of 5. does NOT place the application in condition for allowance because: Applicants' remarks are not convincing. Applicants argue that the 5% different in film rate referred to by the examiner in paper number 21 is regarded as "an extremely large difference to one of ordinary skill in the art". However, applicants have failed to provide any evidence of record to support this position. Applicants further supply an evaluation of profile A and B as set forth in the declaration filed on 12/21/01. Profile A has an angle between the substrate and the sidewall of 85-90 and is considered to be a rectangular shape. Profile B has an angle of 80-85 and is considered to be anything other than a rectangle. Applicants then present the angle values for the examples presented in Table A' of the said declaration. The disclosed angles are all within the range of an A profile as defined by the applicant. The examiner acknowledges that the claimed invention produces profiled having angles within the "ideal" range of 88-89. However, the comparative examples also have angles within the A profile range. In re Soni (54 F.3d 746 750 34 USPQ2d 1684 1687) sets forth the basic rule that which would have been surprising to a person of ordinary skill in the art would not have been obvious. There is no evidence of unexpected results therefore the claimed invention is obvious in light of the prior art.

Furthermore, applicant has failed to provide the said profile angles in declaration form. The arguments are presented by the attorney and not the inventor. In re Klosak (455 F.2d 1077 1080 173 USPQ 14, 16 CCPA 1972) establishes that the burden of showing unexpected results rests with he who asserts them. The applicants are required to explain the testing and the results achieved and the meaning of such tests and result and whether the difference in results is of a practical advantage. The applicant has failed to do that.

The proposed amendment has been entered. However, the position of record is maintain in regard to the rejection of claims 1-15 over Suwa (EP 789278).

The examiner can be reached Monday-Thursday from 8:00 am to 6:30 pm at 703-305-0589.

JANET BAXTER
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